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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,667	06/22/1999	YOSHIHARU SASAKI	Q54770	9266

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EXAMINER

YOCKEY, DAVID F

ART UNIT PAPER NUMBER

2861

DATE MAILED: 02/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/337,667

Applicant(s)

SASAKI ET AL.

Examiner

David Yockey

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached Detailed Action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-5, corresponding dependancies or claim 12, and 17.Claim(s) withdrawn from consideration: 6-11, corresponding dependancies of claim 12 and 13-16.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: The amendment further overcomes the objection to claim 17

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection under 35 USC 112, second paragraph of claims 12/1, 12/2/1, 12/3/1, 12/4/3/1 and 12/5.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 14 January 2002 have been fully considered but they are not persuasive.

Applicant argues that the combination of Takanashi and Michelson is not feasible because the binder material in Takanashi comprises materials which could not be effectively penetrated by a vacuum and, consequently, that this would defeat the ability for the vacuum taught by Michelson to hold subsequent sheets of donor materials to the drum without a redesign of the Michelson reference in way not suggested by Michelson.. This argument is not persuasive because, by Applicant's own admission (Remarks paragraph bridging pages 3 and 4), Michelson teaches that, because some receiving sheets are not permeable to a vacuum source, the donor sheets must extend beyond the receiver sheets by some margin in order for the vacuum to be effective to hold the donor sheets against the drum. Thus, Michelson clearly teaches one of ordinary skill in the art how to hold sheets of donor materials to the drum while using receiver sheets having materials which could not be effectively penetrated by a vacuum.

Applicant argues that if the continuous binder forms of Takanashi were combined with Michelson, the continuous roll form of the binder would necessarily obstruct the vacuum holes in the recording drum and eliminate the ability for the Michelson device to attach successive toner sheets onto the drum. This argument is not persuasive.

Initially, it should be noted that the rejection is directed to a modification of Takanashi by

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provision of cut sheets in therein, as suggested by Michelson, not a modification of Michelson in view of Takanashi. Second, and contrary to Applicant's assertion, the binder would necessarily obstruct the vacuum holes in the recording drum in the combination. Takanashi teaches that the binder is transferred when the receiving sheet 3 is pressed against the binder sheet 4. There is no teaching of contact between the drum 2 and the binder sheet 4 and no teaching of transfer of binder material onto the exposed surface of the drum. Further, since there is no contact between the drum and binder sheet, there can be no transfer of binder to the drum. Consequently, in combination of the Michelson teaching of cut sheets in Takanashi and use of vacuum through holes in the drum as may be necessary to hold the sheets, the binder would not obstruct the vacuum holes in the recording drum.

Applicant argues that Michelson is silent as to binders and how to apply such binders within the apparatus. This argument is not germane to the issue because, as noted above, the combination in the rejection concerns a modification of Takanashi in view of Michelson, not Michelson in view of Takanashi. Takanashi clearly discloses a binder and how it is to be used.

Applicant argues that neither Michelson nor Takanashi makes any suggestions on changes to the form of how the binder should be applied to a recording sheet. This argument is not germane to the issue because no change is necessary nor proposed in the rejection. In Takanashi as disclosed and as modified in view of Michelson, the binder is transferred to the receiving sheet in exactly the same manner.

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Applicant argues that the combination of Michelson and Takanashi would not obviate the additional step for transferring images to a final recording sheet. This argument is not germane to the issue because the claims do not exclude such an additional step; note that the claims are recited as comprising the steps therein, and thus may include additional steps.

Applicants assert that Takanashi is directed to a fundamentally different type of image transfer than Michelson. This assertion is respectfully submitted to be incorrect. As is readily apparent, both Takanashi and Michelson are form images by application of heat to a donor material to transfer toner material (referred to alternately as either toner, ink, or dye) from the donor material to a receiver material. The mere fact that Takanashi provides a coating of binder material to enhance the thermal transfer process does not fundamentally change the image transfer process, as the same thermal transfer steps are performed with or without the additional step of providing a coating of binder material.

Applicant argues patentability of claim 12 by solely attacking the Michelson reference, asserting that Michelson, at best, teaches that lamination of both a plate and a recording sheet may occur in one apparatus. This argument is not persuasive. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Fujimura is not applicable to the present invention and may not be combined with the primary combination because Fujimura relates to the transfer of previously formed images onto a receiving substrate rather than in accordance with certain recording data, and further argues that Fujimura requires simultaneous application of heat and pressure to provide the transfer with heat and pressure being applied on both sides of the image-forming substrate. This argument is not persuasive because, as is clearly indicated with regard to Figs. 3A-3D and discussion pertaining thereto, Fujimura related to transfer of toner in accordance with certain recording data provided to a laser light source 24; use of a thermal head is also disclosed with regard to Fig. 4, showing equivalence of a laser and a thermal head in thermal transfer processes. The mere fact that there is are additional steps pertaining to transferring to another medium does not detract from this teaching. Further, while pressure is applied to both sides of the image-forming substrate while heat is applied to the other in the use of a thermal head, in a like manner to that in Takanashi, it is respectfully submitted that there is no teaching of application of heat to both sides of the image-forming substrate during the image transfer process detailed in Figs. 3A-3D.


Applicant's argument concerning the provision of the cushion layer further defeating the use of vacuum holding power is not persuasive for the same reason as that discussed above with regard to binder material defeating the ability for the vacuum taught by Michelson to hold subsequent sheets of donor materials to the drum.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


DAVID F. YOCKEY
PRIMARY EXAMINER

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January 31, 2002